

REMARKS

Applicants have carefully considered the February 22, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-18 were pending in this application.

In response to the Office Action dated February 22, 2006, claims 4, 6, 8-9, 11-12, 14-15 and 17-18 have been canceled and claims 1, 5 and 7 have been amended. Claim 7 has been amended to correct a typographical error regarding the claim dependency. Independent claim 1, has been amended to provide proper antecedent support for the phrase "top surface of the wear-resistant member" and to further recite a flatness and surface roughness.

Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including page 28, Table III. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Initially, Applicants note that the Examiner did not consider U.S. Pat. No. 6,220,757 which was cited in the Information Disclosure Statement filed March 1, 2005. Applicants respectfully request that the Examiner consider this reference and forward an appropriately initialed copy of the PTO-1449 form with the next Office communication.

The Examiner objected to the specification at page 17, line 1 for a minor informality. In view of the foregoing amendment to the specification at page 17, the Examiner is requested to reconsider and withdraw the objection.

Claims 1-3, 7, 10, 13 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui (JP 08-226419, hereinafter “Matsui”) in view of Taniguchi (U.S. Pat. No. 5,236,274, hereinafter “Taniguchi”). The Examiner asserted that Matsui discloses the limitations of claim 1, but for chamfers on the bottom surface of the wear-resistant material. See page 3 of the office action. With respect to claim 7, the Examiner admitted that Matsui does not disclose the claimed clearance between the wear-resistant material and the recess wall. Nevertheless, the Examiner referred to Taniguchi and asserted that it would have been obvious to have utilized the chamfers of Taniguchi in the valve gear member of Matsui to ensure the bottom portion of the wear-resistant material would be prevented from abrading and sticking to the corresponding walls of the recess with the proper clearance to ensure long-lasting wear. See page 3 of the office action. Applicants respectfully traverse.

Claims 1-3, 7, 10, 13 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki (U.S. Pat. No. 6,237,553, hereinafter “Suzuki”) in view of Taniguchi. The Examiner asserted that Suzuki discloses the limitations of claim 1, but admitted that Suzuki does not disclose horizontal movement of the wear-resistant member, protection from falling out, chamfered edges, a specific clearance and the wear-resistant material being a silicon nitride ceramic. See page 4 of the office action. The Examiner again referred to Taniguchi and asserted that it would have been obvious to have utilized the chamfers of Taniguchi in the valve gear member of Suzuki to ensure the bottom portion of the wear-resistant material would be prevented from abrading and sticking to the corresponding walls of the recess. The Examiner further asserted that Taniguchi’s stopper

would prevent the wear-resistant member from falling out of the recess, the horizontal movement with the proper clearance would help prevent war and abrasion of the upper surface of the cap and the specific composition of the cap would prevent wear and abrasion. See pages 4-5 of the office action. Applicants respectfully traverse.

Claims 4-6, 8, 9, 11, 12, 14, 15, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui in view of Taniguchi and further in view of Nishioka et al. (U.S. Pat. No. 6,237,441, hereinafter "Nishioka"). See pages 5-6 of the office action. With respect to independent claim 4 (now canceled), the Examiner admitted that neither Matsui nor Taniguchi discloses a bottom surface of the wear-resistant member having a specified flatness or convex shape. The Examiner relied on Nishioka and asserted that it would have been obvious to have utilized the teachings of Nishioka in order to provide a specific shape and flatness characteristic and thereby preventing wear and abrasion of the sliding members of the valve device. With respect to independent claim 6 (now canceled), the Examiner admitted that neither Matsui nor Taniguchi discloses a surface roughness of 0.2 μm or less. The Examiner relied on Nishioka and asserted that it would have been obvious to have utilized that teachings of Nishioka in order to provide specific surface roughness characteristics to prevent wear and abrasion of the sliding members of the valve device. Applicants respectfully traverse.

The Examiner asserted that Nishioka teaches a flatness between 0.5-5 μm . However, Applicants submit that this flatness identified by the Examiner is based on the sliding face with cam. Independent claim 1, as amended recites that the bottom surface of the wear-resistant member making contact with an inner radial surface of the recess has a flatness in the range of 0.05 to 2.5 μm (see page 28, Table III of the present specification). Thus, in contrast to Nishioka, the flatness of the present claimed subject matter relates to flatness based on the sliding face with

recess. Thus, the applied references, alone or in combination, fail to disclose or remotely suggest every limitation of independent claim 1 as amended. Accordingly, the rejection is not legally viable for at least this reason and should be withdrawn. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Moreover, the Examiner asserted that Nishioka teaches a sliding shim having a surface roughness of 0.2 μm or less. However, Applicants submit that this surface roughness identified by the Examiner is based on the sliding face with cam, whereas the present claimed subject matter requires the surface roughness based on the sliding face with cam. Thus, the applied references, alone or in combination, fail to disclose or remotely suggest every limitation of independent claim 1 as amended. Accordingly, the rejection is not legally viable for at least this reason and should be withdrawn. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Furthermore, in each of the above rejections under 35 U.S.C. § 103(a), the Examiner is improperly relying on the judicially condemned “obvious to try” rationale. Applicants traverse the rejections and assert that the requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 requires not only a suggestion, but a reasonable expectation of success as to a particular benefit. As the Examiner has not established that the prior art teaches, with a reasonable expectation of success, that a particular benefit would result from the Examiner's proposed combination, Applicants submit that that one having ordinary skill in the art would not have been motivated to modify the references as suggested by the Examiner. Rather, the only basis for such motivation is found in Applicants' disclosure, which the Examiner cannot rely on for the requisite motivational element. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Application No.: 10/526,000

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:idw
Facsimile: 202.756.8087
Date: May 22, 2006

**Please recognize our Customer No. 20277
as our correspondence address.**